

B¹
conceded

4.(Amended) The composition of claim 1 in which said whole processed fruit or vegetable extract is fruit-derived.

B²

7.(Amended) The composition of claim 1 in which said whole processed fruit or vegetable extract is vegetable-derived.

B³

15.(Amended) The composition of claim 1 wherein said whole processed fruit or vegetable extract comprises natural fibers.

sub
C²

B⁴

25.(Amended) A mascara composition comprising a seedless but otherwise substantially whole processed fruit or vegetable extract dispersed in a volatile silicone oil, an antistatic component, a non-plant fiber component, and said whole processed fruit or vegetable extract comprising a natural fiber component.

26.(Amended) The composition of claim 25 in which said whole processed fruit or vegetable extract is apple-derived.

sub
C³

B⁵

30.(Amended) A mascara composition for application to the eyelashes comprising about 0.05 to about 0.50 percent by weight of the composition of a seedless but otherwise substantially whole processed apple extract dispersed in a cyclomethicone, a non-plant fiber component comprising nylon and chitin, an antistatic component comprising chitin, and said whole processed apple extract comprising a natural apple fiber component.

REMARKS

In the Examiner's Final Action dated February 23, 2001, Claims 1, 2, 7-19, 21, 22, 24 and 25 are rejected under 35 U.S.C. §102(b) as being anticipated by Pastour et al. (U.S. Pat. No. 5,523,091, hereinafter referred to as "the Pastour reference") and Claims 1-30 are rejected under 35 U.S.C. §103 as being unobvious in light of the Pastour reference. Specifically, the Examiner argued that the Pastour compositions contain plant extracts that are active principles. In Applicants' Response of May 23, 2001, Applicants further elaborated on the differences between the two "plant extracts" to demonstrate why the Pastour reference fails to disclose the present

invention, and fails to render the present invention obvious. Further, Applicants pointed out that the Pastour reference teaches the incorporation of its plant extracts in the aqueous phase. Therefore, the Pastour reference fails to teach or suggest the present invention of a seedless but otherwise substantially unfiltered plant extract in a silicone oil.

a. Present Invention Uses Whole Processed Fruit or Vegetable

The present invention, as amended, is a mascara composition that contains a whole processed fruit or vegetable extract prepared using seedless but otherwise substantially unfiltered fruit or vegetable. The components of the fruit or vegetable, other than the seeds, are not separated or purified to make the whole processed fruit or vegetable, i.e., the fruit or vegetable extract of the present invention. Specifically at page 3, lines 24 to 32, the term “extract” is defined to have this special meaning such that the extract includes, except for the seeds, all of the constituents of the fruit or vegetable because they are not filtered. As recently supported by the decision in *Hockerson-Halberstadt Inc. v. Avia Group International Inc.*, 55 USPQ2d 1487, 1490 (CAFC 2000), although an ordinary meaning of a claim term is initially used as a default, the term may have a special meaning applied if the term is clearly defined in the specification because the patentee may act as a lexicographer and provide a different, or modified, meaning to the term. *Hockerson*, 55 USPQ2d at 1490 (citing *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (observing that an applicant, acting as a lexicographer, may bestow “a special meaning to a term in order to convey a character or property or nuance relevant to the particular invention”); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1671, 1674 (Fed. Cir. 1994)). The nuance of the present invention is the substantially unfiltered whole processed fruit or vegetable extract whereby the whole pulp and skin are used in the compositions of the present invention. The Pastour reference does not disclose a composition containing a seedless but substantially unfiltered whole processed fruit or vegetable extract as such is defined in the present specification. Further, the Pastour reference fails to disclose the unfiltered fruit or vegetable extract dispersed in silicone oil. Therefore, the Pastour reference fails to disclose the present invention, as amended.

b. Pastour Patent uses a Constituent Separated from Plant

In contrast to the present invention, the Pastour compositions can contain active ingredients such as plant extracts. The present issue is: what is a “plant extract” as the term is

used in the Pastour reference. Unlike the present specification, the Pastour reference is devoid of a special definition of a plant extract, and thus, the ordinary and accustomed meaning of the term applies to the use of the term "plant extract" in the Pastour reference. *Hockerson*, 55 USPQ2d at 1490.

Evidence in the Pastour reference, and reference material indicates that the ordinary use of the term "plant extract" by one skilled in the art means a constituent separated from a whole plant containing a mixture of components. As mentioned in the present specification, at page 3, lines 28 to 30, contrary to the present invention, a plant extract is typically made by a separation procedure which removes the desired constituent from the whole plant. Consistent with this customary definition, an Analytical Chemistry Handbook, defines an "extraction" to be the process of selectively removing a solute, as for example an active principle, from a mixture with solvents, or the like. Dean, J. A., Analytical Chemistry Handbook, Chapter 2.2 Extraction Methods, pp. 2.15 to 2.59, McGraw-Hill (1995)(copy submitted herewith). In addition, the Webster's Encyclopedic Unabridged Dictionary of the English Language defines the noun "extract" to be a solution containing the active principles of a drug, plant juice, or the like, and to be a solid, viscid, a liquid substance extracted from a plant, drug, or the like. The verb "extract" means to separate or obtain (a juice, ingredient, principle, etc.) from a mixture by pressure, distillation, treatment with solvents or the like. Webster's Dictionary, Gramercy Books (1989) p. 505 (copy submitted herewith). As used at column 6, lines 3 to 7 of the Pastour reference, the "plant extract" is the source of the active principle which is extracted from a whole plant (i.e., the plant extract is separated from the whole plant to provide the active principle, oil, or filler.)

The Pastour reference fails to disclose a substantially unfiltered whole processed fruit or vegetable extract in its compositions. A prior art reference fails to anticipate if it does not disclose each and every element of the claimed invention, and if the missing element is not inherent in the prior art reference. *In re Robertson*, 49 USPQ2d 1949, 1951 (CAFC 1999)(citation omitted). To establish inherency, the extrinsic evidence "must make clear that the missing element is necessarily present in the subject matter described in the prior art reference, and that it would be recognized by those of ordinary skill in the art." *Id.* (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)). Only the active principle is used in the Pastour compositions, and one of ordinary skill in the art would recognize that the presence of the other constituents from the unfiltered plant is likely to interfere with the activity of the desired active principle and that the mixture of additional constituents from the whole plant

may cause other qualitative disadvantages to the final composition. Thus, the Pastour reference fails to disclose, expressly or inherently, the seedless but otherwise substantially unfiltered whole processed fruit or vegetable extract of the present invention, as amended.

Further, the Pastour reference also fails to disclose the substantially unfiltered whole processed fruit or vegetable extract dispersed in a silicone oil. The incorporation of plant extracts in the Pastour reference at column 5, line 65 to column 6, line 5, states the following “The aqueous phase can also contain adjuvants . . . It can also comprise active principles such as plant extracts.” Because the Pastour reference does not disclose a seedless but otherwise unfiltered whole processed fruit or vegetable extract and because it does not disclose any type of fruit or vegetable extract dispersed in a silicone oil, it does not anticipate the present invention, as amended. Therefore, the rejection under 35 U.S.C. §102(b) should be withdrawn.

c. Present Invention is Unobviousness

The Examiner asserts that the Pastour reference also renders the present invention obvious because the expected result would be a mascara that is soft, uniform, and has good hold and sensory qualities. Because the plant extract in the Pastour reference is not the whole processed fruit or vegetable extract of the present invention, but rather, as demonstrated above, is a constituent separated from the mixture of constituents in the whole plant this could be expected by one of ordinary skill in the art as the Examiner suggests. The process of extraction filters the desired constituent from the undesired constituents. In the case of fruits and vegetables, some of the undesired constituents include pulp, sugars, and other sticky and tacky compounds. The Pastour reference fails to teach or suggest the incorporation of all of these various constituents, that exist in the unfiltered whole processed fruit or vegetable extract, in its compositions, and therefore, the present invention is unobvious in view of the Pastour reference. The difference between the Pastour reference and the present invention is as simple as the difference between a juice extractor and a kitchen blender. The Pastour reference teaches a plant extract as an example of an active principle removed from the other constituents of the plant. In contrast, the present invention, as amended, is a composition containing a seedless but otherwise substantially unfiltered whole processed fruit or vegetable extract.

The Examiner points out that the Pastour reference fails to teach the specific percent of whole processed plant extract claimed in Claim 3 of the present invention, as amended. However, further, the Pastour reference incorporates its plant extract in the aqueous phase of its

compositions, unlike the compositions of the present invention. Adding pulp and sugar to water increases the tackiness of the water phase, and therefore, the Pastour reference fails to teach or suggest a non-tacky composition containing an unfiltered whole processed fruit or vegetable extract. In contrast to the Pastour reference, the present invention incorporates in its mascara compositions the seedless but otherwise substantially unfiltered whole processed fruit or vegetable extract, and it is surprisingly not tacky. Moreover, the present invention is the whole processed fruit or vegetable extract dispersed in silicone oil. This is not taught or suggested by the Pastour reference.

The achievement of the present invention is surprising as mentioned in Applicants' previous response of January 2, 2001. However, the Examiner interprets the study described in the present specification to mean that 87% or more of the participants rate the mascara of the present invention as performing the same as their currently used mascara, and therefore, the Examiner concludes that the results of the present invention are not surprising. Applicants assert that although the interpretation is correct, the conclusion is not.

The Pastour reference is no different than conventional mascaras, and the ability of the mascara of the present invention to perform as well as traditional mascara is indeed unexpected because it contains nearly all of the components of the fruit or vegetable which would be expected to cause the mascara to perform poorly. As the Examiner has noted the mascara should be easy to apply, soft, uniform, and have good sensory qualities. Formulating a mascara with conventional synthetic ingredients to achieve these qualities is difficult enough. It is not expected that a mascara formula containing raw, substantially unfiltered whole fruit and vegetable extracts would be able to achieve these qualities at all, nonetheless to perform comparably to conventional mascaras that are formulated to achieve these qualities with synthetically derived ingredients. Despite conventional wisdom, the mascara of the present invention containing unfiltered whole processed fruit or vegetable extract (i.e., containing sticky sugar, gummy and tacky pulp) is favorably compared with conventional mascaras that do not contain these ingredients and it is hard to reconcile how this could be anything but surprising.

Finally, the Pastour reference fails to teach or suggest the whole processed seedless apple extract dispersed in a cyclomethicone as described in Claim 30. The Pastour reference discloses that its aqueous phase can comprise active principles such as plant extracts. There is no teaching or suggestion to add the whole processed apple extract to the Pastour compositions. Nor is there any teaching or suggestion to disperse the whole processed apple extract in cyclomethicone.

Therefore, in addition to the arguments presented above with respect to the whole processed plant extract of the present invention, the specific whole processed apple extract dispersed in cyclomethicone is not taught or suggested by the Pastour reference.

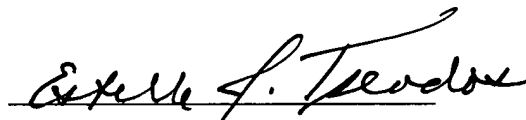
Applicants submit that the amended claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the Pastour reference fails to teach or suggest a substantially unfiltered whole processed fruit or vegetable extract as described in the present specification. Unlike the present invention, as amended, the plant extract in the Pastour reference is separated from the whole plant. Further, the mascara of the present invention containing the unfiltered whole processed fruit or vegetable extract is surprisingly and unexpectedly non-tacky. Thus, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants believe that the present claims are patentable over the cited prior art reference. Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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MARKED AMENDMENTS

Please amend Claims 1 to 4, 7, 15, 25, 26, and 30 as follows:

- 1.(Amended) A mascara composition comprising a seedless but otherwise substantially [unfiltered] whole processed fruit or vegetable [plant] extract dispersed in a silicone oil.
- 2.(Amended) The composition of claim 1 in which said whole processed fruit or vegetable [plant] extract is present in an amount of about 0.05 to about 0.50 percent by weight of the composition.
- 3.(Amended) The composition of claim 2 in which said whole processed fruit or vegetable [plant] extract is present in an amount of about 0.1 to about 0.4 percent by weight of the composition.
- 4.(Amended) The composition of claim 1 in which said whole processed fruit or vegetable [plant] extract is [a] fruit-derived [extract].
- 7.(Amended) The composition of claim 1 in which said whole processed fruit or vegetable [plant] extract is [a] vegetable-derived [extract].
- 15.(Amended) The composition of claim 1 wherein said whole processed fruit or vegetable [plant] extract [component] comprises natural [plant] fibers.
- 25.(Amended) A mascara composition comprising a seedless but otherwise substantially [unfiltered] whole processed fruit or vegetable [plant] extract dispersed in a volatile silicone oil, an antistatic component, a non-plant fiber component, and said whole processed fruit or vegetable [plant] extract comprising a natural [plant] fiber component.
- 26.(Amended) The composition of claim 25 in which said whole processed fruit or vegetable [plant] extract is apple-derived [extract].

30.(Amended) A mascara composition for application to the eyelashes comprising about 0.05 to about 0.50 percent by weight of the composition of [an] a seedless but otherwise substantially whole processed apple extract dispersed in a cyclomethicone, a non-plant fiber component comprising nylon and chitin, an antistatic component comprising chitin, and said whole processed apple extract comprising a natural apple fiber component.